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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,880	10/02/2003	Ulrich Muller	0329-0009.01	9686
26568	7590	09/28/2005	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			BALI, VIKKRAM	
		ART UNIT		PAPER NUMBER
				2623

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/677,880	MULLER ET AL.	
	Examiner	Art Unit	
	Vikkram Bali	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 April 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 8-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. 09/034,481.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding et al (US 5367378) in view of A non contact system for measuring hot strip flatness, by Pirlet et al.

With respect to claim 8, Harding discloses highlighted panel inspection in that as claimed "projecting a shadow in the form of a line pattern onto said metal strip", (see Abstract and figure 1 and also see col. 3, lines 28-30, wherein it shows that a grid 12, is a light box which has a spaced opaque lines and those lines are backlit by a light source, and therefore, a shadow gets projected on to the object); and "detecting said line pattern on said metal strip with a camera", (see Abstract and figure 1, numerical 14 camera for observing the pattern). However, he fails to disclose that the hot metal strip is "moving" as claimed in claim 8. Pirlet in teaches an inspection of the moving hot metal strip (see page 45 col. 1) as claimed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the inspection method to use for the measurements of the panels as described by Harding by introducing the method of measuring the shape of the moving hot metal strip as taught by Pirlet in a non contact system for measuring the hot strip flatness, as both of these two references are solving the same problem of measuring the metal strip. This modification will provide an apparatus that will measure different thickness of the moving metal strips to detect any discrepancies.

With respect to claim 9, Harding further discloses "the line pattern detected by said camera is compared continuously by a computer with a reference pattern", (see Abstract first three lines and figure 1 for the apparatus) as claimed.

With respect to claim 10, Harding further discloses "the line pattern detected by said camera is used for control of a finishing train", (see Abstract, lines 2-3, wherein, the pattern observed by the camera is utilized for the evaluation of the metal strip "control of a finishing train") as claimed.

With respect to newly added claim 14, Harding further discloses "projecting a shadow comprises using a projector to project through a slide", (see col. 3, lines 28-30, wherein, a regularly spaced opaque lines is read as the slide) as claimed.

Claims 11-13 and 15 are rejected as claims 8-10 and 14, because claims 11-13 and 15 are claiming similar subject matter as claims 8-10 and 14 respectively.

#### ***Response to Arguments***

4. Applicant's arguments filed 4/20/2005 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). And, in the instant case, reference Harding discloses highlighted panel inspection in that as claimed projecting a shadow in the form of a line pattern onto said metal strip, as can be

seen from Abstract and figure 1 and also see col. 3, lines 28-30, wherein it shows that a grid 12, is a light box which has a spaced opaque lines and those lines are backlit by a light source, and therefore, a shadow gets projected on to the object, and discloses detecting said line pattern on said metal strip with a camera, see Abstract and figure 1, numerical 14 camera for observing the pattern. And the reference of Pirlet teaches an inspection of the moving hot metal strip, as seen from page 45 col. 1. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the inspection method to use for the measurements of the panels as described by Harding by introducing the method of measuring the shape of the moving hot metal strip as taught by Pirlet in a non contact system for measuring the hot strip flatness, as both of these two references are solving the same problem of measuring the metal strip. This modification will provide an apparatus that will measure different thickness of the moving metal strips to detect any discrepancies.

Applicant argues that the "metal strips contain many irregularities, which appear as random darkened areas on the surface" but this is not claimed in the claims. Also, applicant argues that the "hot metal" is inspected. But, claims 11-13 and 15 did not claim "hot metal".

The declaration filled on 4/20/2005, is made of record. The declaration is attacking the reference individually. And, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Also, the "hot metal" in paragraph 6 is not claimed in

Claims 11-13 and 15. And, the declaration fails to show any facts, and provides only the opinions. And, in this case the person making the declaration stand to benefit from the statements made in the declaration on his expert opinions, and as there was no factual evidence provided the declaration if found to be insufficient (see MPEP 716).

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vikkram Bali whose telephone number is 571.272.7415. The examiner can normally be reached on 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 571.272.7414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vikkram Bali  
Primary Examiner  
Art Unit 2623

vb  
September 20, 2005